## REMARKS

By this amendment, claims 1 and 17 are amended. Claims 1-19 remain pending in this application.

In the Non-Final Office Action mailed March 22, 2006, the Examiner (1) rejected claims 1-4 under 35 U.S.C. § 112, ¶ 2 as being indefinite; (2) rejected claims 1-19 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and (3) rejected claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Hendler et al. (U.S. Patent Application Publication No. 2002/0042833 A1) in view of Basin et al. (U.S. Patent Application Publication No. 2002/0120639 A1).

In light of the above amendments and the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims. Each of the outstanding rejections is addressed under a parallel heading below.

### *Claim Rejections - 35 U.S.C. § 112, ¶ 2*

Claims 1-4 are rejected under 35 U.S.C. § 112, ¶ 2 as being indefinite in that independent claim 1 recites a pronoun ("it"). Applicants respectfully submit that the use of the pronoun "it" in claim 1 did not render the claim indefinite. Applicants know of no *per se* prohibition on the use of pronouns in claims, and Applicants note that independent claim 1 was examined in two previous Office Actions without question as to the antecedent for "it." Nevertheless, solely in order to advance prosecution of the present application, Applicants have amended claim 1 herein to replace "it" with "the central directory." Because claim 17 also used the pronoun "it," Applicants have also amended claim 17 to replace "it" with "the central directory." Support for this

amendment may be found in at least paragraph 017, lines 6-8, of Applicants

specification, and original claims 5 and 11.

### Claim Rejections -- 35 U.S.C. § 101

Claims 1-19 are rejected under 35 U.S.C. § 101 as being drawn to non-statutory

subject matter. Specifically, the Examiner alleges that:

> Independent claims 1, 5, 11 and 17 deals with simple
> mathematical abstract idea. A claim that recites a computer
> that solely calculates a mathematical formula or a computer
> disk that solely stores a mathematical formula is not directed
> to the type of statutory subject matter eligible for patent
> protection. The claims are not producing useful, concrete
> and tangible results.

*Office Action (March 22, 2006)*, p. 3, ll. 13-17.

Initially, Applicants point out that the Examiner has failed, in every respect, to

establish a *prima facie* case that claims 1-19 are directed to non-statutory subject

matter. M.P.E.P. § 2106(II)(A) states:

> Office personnel have the burden to establish a *prima facie*
> case that the claimed invention as a whole is directed to
> solely an abstract idea or to manipulation of abstract ideas or
> does not produce a useful result. Only when the claim is
> devoid of any limitation to a practical application in the
> technological arts should it be rejected under 35 U.S.C.
> 101.... Further, when such a rejection is made, Office
> personnel *must expressly state how the language of the
> claims has been interpreted to support the rejection.*

M.P.E.P. § 2106(II)(A) (8th Ed., Rev. 2, May 2004) (emphasis added).

Although the Examiner alleges that independent claims 1, 5, 11 and 17 do "not

produc[e] useful, concrete and tangible results," the Examiner provides no reasoning or

evidence, beyond pure conjecture, to support the allegation. Accordingly, the

Examiner's conclusion that independent claims 1, 5, 11 and 17 are "not directed to the type of statutory subject matter eligible for patent protection" is wholly unsupported.

In addition, the Examiner's rejection of dependent claims 2-4, 6-10, 12-16, 18 and 19, based solely upon the recitations of independent claims 1, 5, 11 and 17, is wholly improper.

> [W]hen evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.

M.P.E.P. § 2106(II)(C) (8th Ed., Rev. 2, May 2004) (citing *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)).

Because the rejection of claims 1-19 under 35 U.S.C. § 101 is not based upon a consideration of these claims as a whole, and the Examiner has failed to "expressly state how the language of the claims has been interpreted to support the rejection," the Examiner has failed to set forth a *prima facie* case that these claims are non-statutory. Accordingly, Applicants respectfully request that the Examiner either *expressly* state why each of claims 1-19, considered as a whole, are allegedly non-statutory or withdraw the rejection of these claims.

Moreover, the Examiner's failure to establish the required *prima facie* case notwithstanding, each of independent claims 1, 5, 11 and 17 are directed to statutory subject matter, for at least following reasons.

As noted by the Federal Circuit,

> 35 U.S.C. § 101 is broad and general; its language is:
> "any * * * process, machine, manufacture, or composition of
> matter, or any * * * improvement thereof." Section 100(b)
> further expands "process" to include "art or method, and * * *
> a new use of a known process...."

*State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1372. The

three unpatentable categories are: "laws of nature, natural phenomena, and abstract

ideas." Id. at 1373 (citations omitted). "Claims to computer-related inventions that are

clearly nonstatutory fall into the same general categories as nonstatutory claims in other

arts, namely natural phenomena such as magnetism, and abstract ideas or laws of

nature which constitute 'descriptive material.'" M.P.E.P. § 2106(IV)(B)(1).

The inquiry of whether a claim is statutory focuses on "the essential

characteristics of the subject matter, in particular, its practical utility." *State Street*

*Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375. If a claim includes

recitations that produce "a concrete, tangible and useful result," the claim is not abstract

and has practical utility. *See State Street*, 149 F.3d at 1373, *AT&T Corp. v. Excel*

*Communications, Inc.*, 172 F.3d 1352, 1358. And if the claim is not abstract and has

practical utility, it is statutory under 35 U.S.C. § 101. *Id.*

Contrary to the Examiner's assertions, none of independent claims 1, 5, 11 and

17 is directed to "a computer that solely calculates a mathematical formula or a

computer disk that solely stores a mathematical formula." Instead, each of independent

claims 1, 5, 11 and 17 clearly includes recitations that produce "concrete, tangible and

useful" results. With respect to claim 1, for example, at least the steps of "receiving a

stream of data containing an un-extracted zip file," and "enabling a process to access

contents of the central directory as the central directory is received" produce a useful,

concrete, and tangible result. Claims 5, 11 and 17 contain similar recitations.

Moreover, "[i]f a claim defines a useful machine or manufacture by identifying the

physical structure of the machine or manufacture in terms of its hardware or hardware

and software combination, it defines a statutory product." M.P.E.P. § 2106(IV)(B)(2)(a)

(citing *In re Lowry*, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034-35; *In re Warmerdam*,

33 F.3d 1354, 1361-62, 31 USPQ2d 1754, 1760). Applicants note that claim 5 is

directed to "[a] system for receiving a streamed zip file . . . , the system comprising,"

*inter alia*, "a central processing unit; . . . and an interface module . . . for accessing

contents of a central directory of the streamed zip file as the central directory is

received." Similarly, claim 11 is drawn to "[a] computer program product ... comprising a

computer readable storage medium and a computer program mechanism embedded

therein, the computer program mechanism comprising," *inter alia*, "an interface module

for accessing contents of a central directory of the streamed zip file as the central

directory is received." And claim 17 is drawn to "[a] memory for storing data for access

by an application program being executed on a computer system, comprising" *inter alia*,

"an interface stored in the memory, ... the interface comprising a process for accessing

contents of the central directory as the central directory is received." Accordingly, each

of independent claims 5, 11 and 17 is drawn to a statutory product. *Id.*

Because each of independent claims 1, 5, 11 and 17 include recitations that

produce "a concrete, tangible and useful result," these claims are not abstract and have

practical utility. *See State Street*, 149 F.3d at 1373; *AT&T Corp. v. Excel

Communications, Inc.*, 172 F.3d 1352, 1358. Accordingly, claims 1, 5, 11 and 17 and

dependent claims 2-4, 6-10, 12-16, 18 and 19 are statutory under 35 U.S.C. § 101.

Applicants therefore respectfully request that the rejection of claims 1-19 under 35

U.S.C. § 101 be withdrawn and the claims allowed.

### *Claim Rejections -- 35 U.S.C. § 103*

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over

Hendler et al. in view of Basin et al. Applicants note that the rejection of claims 1-19

contained in the Non-Final Office Action mailed March 22, 2006 repeats, virtually

verbatim, the rejection of claims 1-19 contained in the Final Office Action mailed

June 30, 2005. Applicants addressed these rejections in the Arguments section of the

Appeal Brief filed December 29, 2005. However, the Examiner failed to address, or

even acknowledge, these arguments, which are therefore largely repeated below.

Applicants submit that this failure does little to advance prosecution of this application.

### Claim 1

Hendler et al. discloses:

> [A] method of streaming an archive file (such as a Java
> Archive [JAR] file) from a server to a client device. The
> method includes *extracting* files from a Java Archive and
> streaming the *extracted* files from the server to the client
> device, receiving the streamed files and storing the received
> files for access by a Java application.

Hendler et al., ¶ 0009 (emphasis added); *see also* id., ¶¶ 0067, 0073-76. Thus, as the

Examiner admits, Hendler et al. fails to teach "receiving an *un-extracted* zip file." *See*

*Office Action (March 22, 2006)*, p. 4, l. 22-p. 5, l. 1.

In an attempt to cure this deficiency, the Examiner cites <u>Basin et al.</u> as teaching the existence of an "'un-extracted zip file' as these days almost any file one downloads from the Internet is compressed (un-extracted) in some way," and asserts that "it would have been obvious to one of ordinary skill ... to have combined the teachings of [<u>Hendler et al.</u> and <u>Basin et al.</u>] because Basin's teachings would have allowed Hendler's method with an easy management and manipulation of archive files." *Office Action (March 22, 2006)*, p. 5, ll. 1-3 and 8-11. Applicants respectfully disagree.

The Examiner relies on <u>Hendler et al.</u> as teaching "the claimed step of 'enabling a process to access the contents of the central directory as the central directory is received' as the contents of each local file header is repeated in a central directory 640 located at the end of the zip archive [600]." *Office Action (March 22, 2006)*, p. 5, ll. 17-20 (citing <u>Hendler et al.</u>, FIG. 6, and ¶¶ 0069, 0073-74 and 0076). However, in the <u>Hendler et al.</u> method, the JAR (ZIP) file 600 is streamed "as a series of separate modules by *extracting* the ZIP central directory 640, as well as the individual files and their associated headers 631-636, and streaming each of these [extracted] elements 631-636, 640 separately." <u>Hendler et al.</u>, ¶ 0073, ll. 2-7 (emphasis added).

Consequently, in <u>Hendler et al.</u>, the central directory record 640 is streamed, and therefore received, *separately*, and in *extracted* form. <u>Id.</u>; *see also* <u>id.</u>, ¶¶ 0067, and 0073-76. In the method of claim 1, the zip file, which "comprises a set of files and a central directory," (<u>claim 1</u>, ll. 2-3) is received in "un-extracted" form (<u>id.</u>, l. 2). Thus, contrary to the Examiner's assertions, <u>Hendler et al.</u> does not "enable a process to access contents of the central directory *as the central directory is received*," because the process by which <u>Hendler et al.</u> accesses the contents of the central directory

requires that the central directory to be extracted prior to receipt. *See* id., ¶ 0073, 0074 and 0076.

Moreover, Basin et al. teaches that "[g]enerally, the contents of a compressed file cannot be accessed unless the archive is uncompressed." Basin et al., ¶ 0004, ll. 1-2. Thus, Basin et al. does not cure this deficiency. Instead, Basin et al. teaches that "[w]hen files are dropped [(i.e., downloaded)] from archive to Explorer, Explorer requests available standard data formats. In this instance, the data object will need to uncompress the data." Basin et al., ¶ 0032, ll. 6-9. In order to extract individual files and/or folders archived in a zip file, "a user opens the zip file in Explorer ... and invokes the extract dialog, by selecting the Extract menu item in the right-click context menu. .... Alternatively, a user may select PKZIP|Extract Here to extract the contents of the archive into the directory where the zip archive resides." Id., ¶ 0037, ll. 1-8. Thus, the Basin et al. method would allow the central directory to be accessed only *after* the entire zip file has been received and extracted by the user. Id.

Consequently, even if the artisan would have been motivated to modify Hendler et al. by streaming the JAR file in un-extracted form (which Applicants dispute), neither Hendler et al., nor Basin et al., nor their combination, teach a process for accessing the central directory "as the central directory is received." For at least these reasons, Hendler et al. and Basin et al. fail to support the Examiner's rejection of claim 1, whether taken alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

## Claims 2-4

Claims 2-4 depend from claim 1. As explained above, the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) is not supported by <u>Hendler et al.</u> and <u>Basin et al.</u>, whether taken alone or in combination. Therefore, the Examiner's rejections of claims 2-4 under 35 U.S.C. § 103(a) are likewise not supported by <u>Hendler et al.</u> and <u>Basin et al.</u> for at least the same reasons given above with respect to claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-4 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

## Claims 5 and 11

In the rejections of claims 5 and 11, the Examiner asserts that <u>Hendler et al.</u> teaches "'a receiving module ... for receiving a streamed un-extracted zip file' as the receiving device 410 includes a streaming execut[o]r 416 that controls the receipt of the streamed modules." *Office Action (March 22, 2006)*, p. 7, ll. 11-14 (citing <u>Hendler et al.</u>, FIGS. 4 and 6; and ¶ 0075); *see also* <u>id.</u>, p. 9, ll. 15-18. However, the Examiner admits that <u>Hendler et al.</u> fails to teach "receiving an un-extracted zip file" *See* <u>id.</u>, p. 7, l. 15, and p. 10, ll. 1. Therefore, contrary to the Examiner's assertions, <u>Hendler et al.</u> fails to teach "a receiving module ... for receiving a streamed *un-extracted* zip file."

The Examiner again cites <u>Basin et al.</u> as teaching the existence of an un-extracted zip file, and asserts that it would have been obvious to the artisan to combine <u>Hendler et al.</u> and <u>Basin et al.</u> to arrive at the claimed invention. *Office Action (March 22, 2006)*, p. 7, l. 15 -- p. 8, l. 4; <u>id.</u>, p. 8, ll. 1-11. Applicants respectfully disagree.

The Examiner asserts that <u>Hendler et al.</u> teaches "'an interface module, initiated by the application program, for accessing contents of the streamed zip file as [the central directory] is received' as the integration of streamed modules with executing modules are provided by client 410 dynamic module linking facilities." <u>Id.</u>, p. 8, ll. 5-9 (citing <u>Hendler et al.</u>, FIGS. 4 and 6; and ¶¶ 0064-65, 0073-74 and 0076); *see also* <u>id.</u>, p. 10, ll. 12-16. However, the cited portions of <u>Hendler et al.</u> make no reference to "receiving a streamed *un-extracted* zip file." Instead, as explained above, <u>Hendler et al.</u> teaches to stream zip files as a series of separate modules in *extracted* form. *See* <u>Hendler et al.</u>, ¶ 0073, ll. 2-7. Thus, contrary to the Examiner's assertions, <u>Hendler et al.</u> fails to teach "'an interface module, initiated by the application program, for accessing contents of the streamed zip file as [the central directory] is received.'"

Moreover, <u>Basin et al.</u> is not relied upon to teach, and does not teach, the claimed interface module. As explained above, <u>Basin et al.</u> provides access to the central directory only *after* the entire zip file has been received and extracted by the user. <u>Basin et al.</u>, ¶ 0032, ll. 6-9; ¶ 0037, ll. 1-8. Consequently, even if the artisan would have been motivated to modify <u>Hendler et al.</u> by providing a receiving module for receiving a streamed un-extracted zip file (which Applicants dispute), neither <u>Hendler et al.</u>, nor <u>Basin et al.</u>, nor their combination, teach "'an interface module, initiated by the application program, for accessing contents of the streamed zip file as [the central directory] is received.'"

For at least these reasons, <u>Hendler et al.</u> and <u>Basin et al.</u> fail to support the Examiner's rejection of claims 5 and 11. Accordingly, Applicants respectfully request

that the rejection of claims 5 and 11 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

### Claims 6 and 12

Claim 6 and 12 depend from claims 5 and 11, respectively. As explained above, the Examiner's rejections of claims 5 and 11 under 35 U.S.C. § 103(a) lack support in Hendler et al. and Basin et al., whether taken singly or in combination. Therefore, the Examiner's rejections of claims 6 and 12 likewise lack support in Hendler et al. and Basin et al. for at least the same reasons given above with respect to claims 5 and 11. Accordingly, Applicants respectfully request that the rejection of claims 6 and 12 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

In addition, in the rejections of claims 6 and 12, the Examiner asserts that Hendler et al. teaches that "'the interface module is a Java class comprising a central header subclass and a central directory subclass' as the streamed modules have a Java class comprising central directory headers 641-646 and central directory 640 as subclasses." *Office Action (March 22, 2006)*, p. 8, ll. 10-13 and p. 10, ll. 17-20 (citing Hendler et al., FIG. 6; and ¶ 0084). Applicants respectfully disagree with the Examiner's characterization of Hendler et al.

Contrary to the Examiner's assertions, the cited portions of Hendler et al. describe *the streamed file*, itself, and not the alleged interface. As disclosed by Hendler et al., "an *extracted file* may be further subdivided before streaming. For example, [manifest] *file 601* may be a class file containing several Java classes. Individual classes may be extracted from the file 601 and streamed as separate

modules." <u>Hendler et al.</u>, ¶ 0084, ll. 1-5. Nowhere does <u>Hendler et al.</u> teach an interface module "for accessing contents of a central directory of the streamed zip file as the central directory is received", "wherein *the interface module* is a Java class comprising a central header subclass and a central directory subclass," as alleged by the Examiner. *Office Action (March 22, 2006)*, p. 8, ll. 10-13 and p. 10, ll. 17-20 (emphasis added). Moreover, <u>Basin et al.</u> is not relied upon to teach, and, in fact, does not teach the cited deficiencies of <u>Hendler et al.</u>

For at least these additional reasons, the Examiner's rejection of claims 6 and 12 lacks support in <u>Hendler et al.</u> and <u>Basin et al.</u>, whether taken alone or in combination. Accordingly, Applicants respectfully request that the rejections of claims 6 and 12 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

### Claims 7-10 and 13-16

Claims 7-10 depend from claim 6; claims 13-16 depend from claim 12. As explained above, the Examiner's rejections of claims 6 and 12 under 35 U.S.C. § 103(a) lack support in <u>Hendler et al.</u> and <u>Basin et al.</u>, whether taken singly or in combination. Therefore, the Examiner's rejections of claims 7-10 and 13-16 under 35 U.S.C. § 103(a) likewise lack support in <u>Hendler et al.</u> and <u>Basin et al.</u> for at least the same reasons given above with respect to claims 6 and 12. Accordingly, Applicants respectfully request that the rejections of claims 7-10 and 13-16 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

## Claim 17

In the rejection of claim 17, the Examiner asserts that Hendler et al. teaches

> "an interface stored in [a] memory, the interface for use with
> a receiver configured for receiving a streamed ...
> un-extracted zip file, wherein the zip file comprises a set of
> files and a central directory, the interface comprising a
> process for accessing contents of the central directory as it
> is received" as the receiving device 410 includes a streaming
> execut[o]r 416 that controls the receipt of the streamed
> modules.

Office Action (March 22, 2006), p. 12, ll. 5-11 (citing Hendler et al., FIGS. 4 and 6; and

¶ 0073-0076). The Examiner also cites Basin et al. as teaching the existence of an

un-extracted zip file, and asserts that it would have been obvious to the artisan to

combine Hendler et al. and Basin et al. to arrive at the claimed invention. Id., p. 12,

l. 14, et seq. However, Applicants respectfully disagree with the Examiner's

characterization of the cited references.

As the Examiner admits (id., p. 12, l. 14), Hendler et al. fails to teach "receiving

an un-extracted zip file." Therefore, contrary to the Examiner's assertions,

Hendler et al. fails to teach "an interface for use with a receiver configured to receive a

streamed un-extracted zip file." As explained above, Hendler et al. teaches to extract

the zip file before streaming its constituent files. See Hendler et al., ¶¶ 0073-76.

Consequently, Hendler et al. fails to teach "a process for accessing contents of [a]

central directory as the central directory is received."

Moreover, Basin et al. does not cure this deficiency. Instead, the Basin et al.

method allows the central directory to be accessed only after the entire zip file has been

received and extracted by the user. Basin et al., ¶ 0032, ll. 6-9, ¶ 0037, ll. 1-8.

Consequently, even if the artisan would have been motivated to modify Hendler et al. by streaming the JAR file in un-extracted form (which Applicants dispute), neither Hendler et al., nor Basin et al., nor their combination, teaches "an interface ... for use with a receiver configured for receiving a streamed un-extracted zip file, wherein the zip file comprises a set of files and a central directory, the interface comprising a process for accessing contents of [a] central directory as the central directory is received."

For at least these reasons, Hendler et al. and Basin et al. fail to support the Examiner's rejection of claim 17, whether taken alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 17 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

### Claims 18-19

Claims 18 and 19 depend from claim 17. As explained above, the Examiner's rejection of claim 17 under 35 U.S.C. § 103(a) is not supported by Hendler et al. and Basin et al., whether taken alone or in combination. Therefore, the Examiner's rejections of claims 18 and 19 are likewise not supported by Hendler et al. and Basin et al. for at least the same reasons given above with respect to claim 17. Accordingly, Applicants respectfully request that the rejection of claims 18 and 19 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

## Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully

request reconsideration and reexamination of this application and the timely allowance

of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 21, 2006          By:_____
                                   John M. Mulcahy
                                   Reg. No. 55,940